Remarks:

In the March 22, 2005, Office Action, Claims 1, 7, and 9-11, 13, and 15-17 were rejected under 35 U.S.C. Section 102(b) as being anticipated by Kolling et al. (U.S. Patent No. 5,963,925). Claims 2-4, 8, 18, and 19 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Kolling et al. Claims 5, 6, 12, and 14 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Kolling et al. in view of Chang (U.S. Patent No. 5,848,400).

In this Amendment B, Applicant has cancelled Claim 2 and inserted limitations which parallel those formerly in Claim 2 into Claim 1.

Applicant's invention is directed to an electronic bill presentment and payment ("EBPP") system in which by processing bill payments made by customers to a biller, a service provider can data mine the payments to obtain information which will allow electronic bills to be presented directly to the customers through the customers' banks in the future. This is accomplished even though the customers have not signed up for bill presentment.

The Kolling et al. reference (U.S. Patent No. 5,963,925), on the other hand, is an electronic bill presentment system which is only capable of accepting electronic billing information from billers and presenting it electronically to consumers. The Examiner concedes that the Kolling et al. reference "does not disclose data mining the payment to obtain customer's financial institution data that distinctly identifies a customer's financial

institution." Rather, the Kolling et al. reference simply replaces the preparation and mailing of paper statements and invoices from a biller with electronic delivery of the bills and nothing more. Kolling et al. is thus completely and utterly irrelevant to Applicant's invention.

The Chang reference (U.S. Patent No. 5,848,400) teaches a high level banking system in which servers are used by banks to perform electronic payments and to send bills. There is not a single word in the entire Chang reference which teaches or suggests obtaining information on customers through the processing of payments from them to enable the presentment of bills to such customers. Once again, in the March 22, 2005, Office Action, the Examiner has glossed over the limitations in the claims which require such activity and are clearly not taught by Chang.

In particular, Claim 2 (the limitations of which have essentially been added in this Amendment B to independent Claim 1) and Claims 18 and 19 were all rejected as being obvious over the Kolling et al. reference. In making this rejection, the Examiner has stated that "data mining the payment to obtain customer's financial institution data that distinctly identifies a customer's financial institution is well known in the art. ... Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature with Kolling's ..."

This is per se an invalid rejection. It is little more than an explicit admission by the Examiner that the Examiner was unable to find a large part of Applicant's claims in

the prior art, and that instead of allowing the claims as is required by the law, the Examiner instead relied upon an incorrect assertion that clearly is in violation of proper procedure. "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. ... It is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. In Re Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697 ('[T]he Board cannot simply reach conclusions based on its own understanding or experience-or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.')." MPEP Section 2144.03.

The Examiner's attention is also drawn to the requirement that office actions must comply with the well-defined requirements of the Administrative Procedure Act, "which governs the proceedings of administrative agencies and related judicial review, establishes a scheme of 'reasoned decisionmaking.' Not only must an agencies decreed result be within the scope of its lawful authority, but the process by which it reaches that result must be logical and rational." Allentown Mack Sales and Service, Inc. v. National Labor Relations Bd., 522 U.S. 359, 374 (1998), cited in In re Sang Su Lee, 00-1158 (Serial No. 07/631,240) (Fed. Cir. 2002). "This standard requires that the agency not

only have reached a sound decision, but have articulated the reasons for that decision." In re Sang Su Lee, supra.

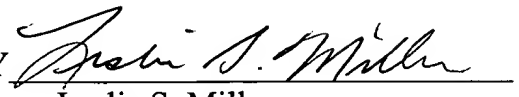
With regard to Claims 1, 18, and 19, the Examiner has conceded that nothing the Kolling et al. reference teaches a number of elements of these independent claims. Claims 1, 18, and 19 are quite simply not obvious in view of the fact that multiple elements of each of these claims are not taught or suggested in any way by the Kolling et al. reference. Thus, it is evident that Claims 1, 19 and 19 are neither taught nor suggested by the Kolling et al. reference. Thus, Applicant submits that Claims 1, 18 and 19 are patentable over the Kolling et al. reference, and the Section 103 rejection is improper and must be removed.

Claims 3 through 17, which depend from Claim 1, are also patentable in view of the patentability of Claim 1, and no further arguments with regard to these claims is believed to be required.

Accordingly, Applicant believes that Claims 1 and 3-19 are patentable at this time. These claims remain pending following entry of this Amendment B, and are in condition for allowance at this time. As such, Applicant respectfully requests entry of the present Amendment B and reconsideration of the application, with an early and favorable decision being solicited. Should the Examiner believe that the prosecution of the

application could be expedited, the Examiner is requested to call Applicant's undersigned attorney at the number listed below.

Respectfully submitted:

BY 

Leslie S. Miller
Attorney for Applicant
Registration No. 30,662

Reinhart Boerner Van Deuren s.c.
1000 North Water Street, Suite 2100
Milwaukee, WI 53202

(414) 298-8321

Customer No. 22922